

REMARKS

Claims 1, 3, 6-11, 14-18, 21-24, 27-31, 34-38, 41-44, 52, and 53 are pending in the present Application. No amendments have been made in this response. Reconsideration and allowance of the claims are respectfully requested in view of the following remarks.

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 1, 3, 6, 7, 9-11, 14-18, 21-24, 27-28, 30-31, 34-38, 41-42, 44, and 52-53 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over United States Patent No. 4,927,859 to Weber in combination with United States Patent Nos. 4,350,793 to Schmidt and 5,525,636 to Henn, et al. (Henn). Claims 8, 29, and 43 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over Weber in combination with Schmidt and Henn and further in view of United States Patent No. 4,618,633 to Taubitz, et al. (Taubitz). Applicants respectfully traverse these rejections.

The Examiner has summarized her arguments based on these references by saying “The differences between the invention claimed in the broad claims of the instant application and the disclosure of the Weber reference is that the Weber reference does not expressly disclose the molecular weight of suitable polystyrenes and that the method of making the claimed product disclosed in Weber is different from the claimed method steps insofar as the blowing agent, in the process of Weber, is added via impregnation and the claimed step calls for melt blending the blowing agent.” (Office action dated September 24, 2007, page 2). The Examiner goes on to assert that it would have been obvious for the ordinary artisan, in view of Schmidt and Henn, to choose a polystyrene having a molecular weight as instantly claimed. The Examiner makes the further point that although the claims are drafted as product-by-process the patentability lies in the product itself and states “that since the claimed product is obtained from substantially the same materials, and, since the degree of impregnation (level of blowing agent in expandable product prior to expansion step) disclosed in Weber and exemplified in illustrative examples are similar, it is reasonable believed that the products claimed are substantially identical to the product of Weber absent showing factual evidence to the contrary.” (Office Action dated September 24, 2007, page 3). However, later in the same Office Action, when refuting the Applicants arguments regarding unexpected results the

Examiner contradicts this earlier statement by saying “Moreover, it is well known in the art that the specific steps of blending blowing agents via different processes result in different properties of the final products” (Office Action dated September 24, 2007, pages 3-4).

Applicants take issue with these contradictory statements and believe that the Examiner has failed to establish a prima facie case of obviousness.

Applicants also take issue with the Examiner’s statement as follows “it is reasonable believed that the products claimed are substantially identical to the product of Weber absent showing factual evidence to the contrary. As such, they inherently exhibit the claimed properties. It is further noted that the sound level is claimed as "about 60", i.e., not claimed with any specified exactitude and, thus, is met by any sound level unless this property change leads to a material change in quality of the product.” (Office Action dated September 24, 2007, page 3). Aside from the continued contradiction noted above the Examiner has both disregarded a claim limitation apparently due to the presence of the word “about” and made an obviousness rejection based, at least in part, on inherency. With regard to the word “about” Applicants note that it’s presence does not negate the limitation that it modifies and this limitation could not be met by “any sound level” as alleged by the Examiner – use of the word “about” merely allows for the imprecision associated with the method of measurement associated with the claimed physical parameter. Measurement of sound levels is not so imprecise as to allow any sound level to meet the limitation of “less than or equal to about 60 decibels”.

Furthermore, it is respectfully submitted that the Examiner has inappropriately used the doctrine of inherency in putting forth a rejection under 35 U.S.C. §103 (a). The courts have repeatedly made the distinction that “the inherency of an advantage and its obviousness are entirely different questions. That which may be inherent is not necessarily known.

Obviousness cannot be predicated on what is unknown.” *In re Spormann*, 150 U.S.P.Q. 449, 452, (CCPA, 1966), citing *In re Adams*, 53 CCPA 996, 356 F.2d 998, 148 U.S.P.Q. 742.

“Further it confuses anticipation by inherency, i.e., lack of novelty, with obviousness, which though anticipation is the epitome of obviousness, are separate and distinct concepts.” *Jones et al. v. Hardy*, 220 U.S.P.Q. 1021, 1025 (CCPA, 1984) citing *In re Pearson*, 494 F.2d 1399,

181 U.S.P.Q. 641 (CCPA, 1974); *In re Oelrich*, 666 F.2d 578, 212 U.S.P.Q. 323 (CCPA, 1981). “The examiner should be aware that inherency and obviousness are distinct concepts.” *Ex parte GPAC Inc.*, 29 U.S.P.Q.2d 1401, 1415, n. 15, citing *In re Naylor*, 369 F.2d 765, 152 U.S.P.Q. 106 (CCPA 1966); *In re Henderson*, 348 F.2d 550, 146 U.S.P.Q. 372 (CCPA 1965). “The theory of inherency is normally reserved for rejections under 35 U.S.C. § 102.” *In re Grasseli*, 318 U.S.P.Q. 303 (Fed. Cir. 1983). Withdrawal of the rejection of obviousness under inherency is respectfully requested.

Claims 1, 3, 6, 7, 9-11, 14-18, 21-24, 27-28, 30-31, 34-38, 41-42, 44, and 52-53 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over Weber in combination with Schmidt and Henn and further in combination with United States Patent No. 5,000,891 to Green. Claims 8, 29, and 43 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over Weber in combination with Schmidt and Henn and further in view of Taubitz and further in combination with Green. Applicants respectfully traverse these rejections.

In making the rejection the Examiner has stated “should the claimed product obtained by the claimed process steps be materially different from the product obtained by the process disclosed in Weber, obtaining the claimed product via the claimed steps would have been obvious in view of the disclosure of Green Each method is known for its advantages and choice of one of them that correspond to the claimed step would have been obvious for its known advantages” (Office Action dated September 24, 2007, page 5) The Examiner appears to be implying that any polymeric composition can be used in any known method for the production of expanded compositions. Applicants vigorously disagree. The selection of process and composition is not obvious as both process and composition affects the final product. Applicants respectfully note that Green supports this position and the totality of Green’s teachings must be considered – namely Green’s statements in col. 4 that “It should be noted that the selection of the ingredients, as well as their preparation in the formation of the extrusion mixture, appears to be critical” and “the expandable polystyrene pellets of the present invention are prepared not only by a unique combination of raw materials, but also by a unique combination of processing conditions and processing steps.”

Furthermore, Applicants note that the requirement for a determination of obviousness is that "both the suggestion and the expectation of success must be founded in the prior art, not in applicant's disclosure" (emphasis added). In re Dow Chem., 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988). An Examiner thus cannot base a determination of obviousness on what the skilled person in the art might try or find obvious to try. Rather, the proper test requires determining what the prior art would have led the skilled person to do, with a reasonable expectation of success. Here, Green is quite specific that the process taught by his disclosure is applicable to a specific composition which differs significantly from the composition of the pending claims. Given this teaching Applicants assert that there is no reasonable expectation of success to be found in the cited references.

Reconsideration and withdrawal of this rejection are respectfully requested.

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance are requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 50-1131.

Respectfully submitted,

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